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PATENT

Customer Number 22,852
Attorney Docket No. 1147-0142

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Reissue Application of:)
U.S. Patent No. 5,750,338)
)
Mark L. Collins et al.) Group Art Unit: 1655
)
Reissue Serial No.: 09/533,906) Examiner: Diana B. Johannsen
)
Reissue Application Filed: March 8, 2000)
)
For: TARGET AND BACKGROUND)
CAPTURE METHODS WITH)
AMPLIFICATION FOR AFFINITY)
ASSAYS)

BOX REISSUE LITIGATION

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

**SUPPLEMENTAL REISSUE DECLARATION
UNDER 37 C.F.R. §§ 1.172 and 1.175**

As a duly authorized representative of the assignee of the entire interest in this patent, I, Norval B. Galloway, do hereby state and declare as follows:

1. I am counsel of record for Vysis, Inc., the Assignee of the entire right, title, and interest in U.S. Patent No. 5,750,338 by virtue of an assignment from the inventors to Amoco Corporation in a predecessor application (U.S. Serial No. 07/136,920), recorded at Reel 4843, Frame 0373, and by virtue of a subsequent Assignment of Patents and Applications from Amoco Corporation to Vysis Inc, recorded at Reel 012407, Frame 0200. I am authorized to sign this paper on behalf of the Assignee.

2. I believe that Mark L. Collins, Donald N. Halbert, Walter King, and Jonathan M. Lawrie are the original joint inventors of the subject matter which is described and claimed in United States Patent No. 5,750,338, granted on May 12, 1998, and for which a reissue patent is sought on the invention entitled "Target and Background Capture Methods with Amplification for Affinity Assays." Each inventor is a citizen of the United States of America and the inventors reside at the following addresses:

Mark L. Collins: 12887 Baywind Point, San Diego, California 92130

Donald N. Halbert: 927 Wilshire Drive, Libertyville, Illinois 60048

Walter King: 1996 Somerset Lane, Wheaton, Illinois 60187

Jonathan M. Lawrie: 411 Livingstone Drive, Cary, North Carolina 27513

3. I have reviewed and understand the contents of the above-identified specification, including the original patent claims, and the claims amended and added during the reissue application in the Preliminary Amendment, Second Preliminary Amendment, Supplemental Preliminary Amendment, and Amendment. I also believe that none of the submitted claims enlarges the scope of the claims of the original patent.

4. I acknowledge the duty to disclose information that is material to patentability and to the examination of this reissue application in accordance with 37 C.F.R. § 1.56.

5. I believe that U.S. Patent No. 5,750,338 is partially inoperative or invalid by reason of the Patent Owner claiming more or less than the Patent Owner had a right to claim in U.S. Patent No. 5,750,338. Specifically, in a related litigation between the Patent Owner and the Protestor, Gen-Probe Inc., the Protestor has raised certain contentions that have revealed the possibility of latent ambiguities in the language used in the original patent claims 1, 7, and 19.

First, Gen-Probe has contended in the litigation that the nature of the amplification steps was not established by the original claim language. The Patent Owner, by this reissue application, seeks to correct this error by amending original claims 1, 7, and 19 to recite "*in vitro* amplification."

Second, Gen-Probe has contended that the order of the target capture and amplification steps was not established by the original claim language. Similarly, in the outstanding Office Action, the Examiner rejected claims 1-19 and 41-53 under 35 U.S.C. § 112, 2nd para., on the grounds that it was unclear in claims 1, 7, and 19 whether the amplification step was intended to refer back to step (a) or step (b). The Patent Owner, by this reissue application, seeks to correct this error by amending original claims 1, 7, and 19 to recite "amplifying *in vitro* the separated target polynucleotide."

6. All errors which are being corrected in the present reissue application up to the time of the filing of this supplemental oath/declaration, and which are not covered by a prior oath/declaration submitted in this application, arose without any deceptive intent on the part of the applicant.

7. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

March 8, 2002

Date

Norval B. Galloway

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